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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,822	01/08/2002	Helmut Hintz	1999DE503	1397

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EXAMINER
YOON, TAE H

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 06/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/889822	Hintz et al
Examiner	**Group Art Unit**
T. Yoon	1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 1-8-02, Pre Amdt.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-12 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-12 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)–(d)

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)–(d).

☒ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____ .

☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____ .

Attachment(s)

☒ Information Disclosure Statement(s), PTO–1449, Paper No(s). 3

☐ Interview Summary, PTO–413

☒ Notice of Reference(s) Cited, PTO–892

☐ Notice of Informal Patent Application, PTO–152

☐ Notice of Draftsperson's Patent Drawing Review, PTO–948

☐ Other _____

Office Action Summary

The recited "preferably ----" in lines 6-9" in claim 9 is objected, and a separate claim having such narrower limitation is suggested.

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Replacement of "use of" in line 1 with "method of using" is suggested.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,025,427. Although the conflicting claims are not identical, they are not patentably distinct from each other because 100% colloid dispersion which is claimed in said patent falls within the scope of the instant remoistenable adhesive system as evidenced by the instant claim 2. Also, the colloid dispersion mixture of said patent inherently contains other polymer dispersion as evidenced by examples 3 and 4 of said patent.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited "water-insoluble monomer" lacks an antecedent basis and it should be "water-insoluble **co**monomer".

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 8 and 10-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Colon et al (US 4,325,851) or Sirota et al (US 3,888,811).

Colon et al teach water-activatble adhesive composition comprising a vinyl pyrrolidone(VP)/vinyl acetate (VA) copolymer at col. 3, lines 28-45 wherein the ratio of VP to VA is taught as 3:1 to 1:3. Another words, said ratio is 75-25 wt% of VP and 25-75 wt% of VA which encompasses the instant amount or ratio. PEG surfactants taught at col. 5, lines 3-13 would form a micelle under particular condition and the instant claim does not require forming of a micelle. The use of other polymer such as ethylene/vinyl acetate copolymer is also taught at col. 4, lines 14-42 and in examples. The applications are taught at col. 1, lines 5-13.

Sirota et al teach the same in examples. The ratio of 70-10 wt% of VP and 30-90 wt% of VA taught at col. 4, line 31-45 encompasses the instant amount or ratio. The applications are taught at col. 1, lines 11-20.

An invention in a product-by-process claim is a product, not a process. See ***In re Brown***, 459 F2d 531, 173 USPQ 685 (CCPA 1972) and ***In re Thorpe***, 777 F2d 695, 697, 227 USPQ 964 (Fed. Cir. 1985). Since the PTO does not have equipments to conduct the test, it is fair to require applicant to shoulder the burden of proving that his adhesive differs from that of Colon et al. ***In re Best***, 195 USPQ 430,433 (CCPA 1977). Also, see ***In re Mills***, 477 F2d 649, 176 USPQ 196 (CCPA 1972); Reference must be considered for all that it discloses and must not be limited to its preferred embodiments or working examples. Thus, the instant invention lacks novelty.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yeung et al (US 5,376,447).

Yeung et al teach a water moistenable adhesive comprising a stable emulsion, surfactant or protective colloid and water in abstract and examples. Emulsifiers in tables would form a micelle. Note that vinyl acetate (VA) is hydrolyzed as seen in table V, and said hydrolyzed vinyl acetate, vinyl alcohol, is water soluble. Thus, the example 3 using 80:20 (VA:VP in table I) with 65% hydrolysis (table V) would yield 72% of water soluble monomer. The instant water-insoluble monomers of claim 7 is taught in claim 9. Protective colloids such as polyvinyl alcohol and their

use with surfactants (emulsifiers) are taught at col. 7, lines 4-10 and 28-31. Wallpapers having an adhesive thereon meet the instant adhesive binders and adhesives for the flooring sector absent particular substrates since one can apply said wallpapers on the floor. Thus, the instant invention lacks novelty.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Pat. 3,696,065 neither teach the presence of a micelle-forming emulsifier nor 70-95% by weight of at least one water-soluble monomer (such as vinyl pyrrolidone) contrary to the European Search Report. US 5,426,163 teaches adhesive compositions comprising vinyl pyrrolidone/vinyl acetate copolymer, but the amount of said vinyl pyrrolidone is 15-40% by weight which is away from the instant 70-95% by weight.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/June 19, 2003

TAE H. YOON
PRIMARY EXAMINER